

## **REMARKS**

### ***Status of the Claims***

Claims 1-3 and 5-18 are presently pending in this application and stand rejected. Reconsideration is respectfully requested.

### ***Amendments to the Claims***

Independent claim 1 is amended to recite a cutting element being substantially wedge-shaped and extending radially, rather than distally, outward from the elongate member, per the Examiner's suggestion.

Applicants add new independent claims 34 and 35. New claim 34 includes the limitations of claim 1 as previously presented and additionally recites that the cutting element has a cutting edge that has a substantially arcuate shape. Support for this amendment can be found throughout the application, for example in paragraph [0030]. New claim 35 includes the limitations of claim 1 as previously presented and additionally requires a cutting element that is substantially wedge-shaped such that a width of the cutting element increases in a proximal to distal direction. Support for this amendment can be found throughout the application, for example in paragraph [0029]. No new matter is added.

### ***Claim Objections***

The Examiner objects to claims 1-18 because the term "distally extending" as used in claim 1 is unclear. Applicants amend claim 1 to recite "radially extending" as the Examiner suggests, thereby obviating the basis for the objection.

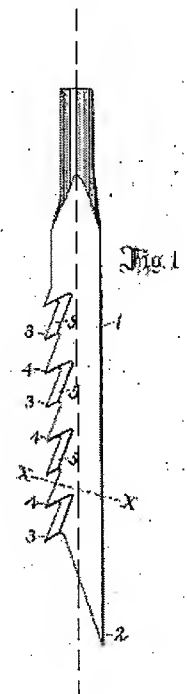
### ***Claim Rejections***

#### **Ruppert and Scholl**

Claims 1-3 and 5-15 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 571,400 of Ruppert in view of U.S. Patent No. 6,110,175 of Scholl.

Independent claim 1 recites a device having an elongate member with proximal and distal ends and an inner lumen extending therebetween. The inner lumen is adapted to receive a guidewire. Claim 1 also recites a cutting element disposed proximal to the distal end of the elongate member. The cutting element is substantially wedge-shaped and extends radially outward from the elongate member. The Examiner argues that Ruppert discloses the limitations of claim 1 except for an inner lumen extending between a proximal end and a distal end of an elongate member that is adapted to receive a guidewire. The Examiner thus relies on Scholl to disclose an inner lumen adapted to receive a guidewire, arguing that the motivation behind modifying Ruppert with Scholl is “to provide a chisel for removing bone that can assess impaction into the bone and can be used with a guide wire.” *See Office Action dated November 23, 2007*. Applicants respectfully disagree.

At the outset, the motivation that the Examiner provides for modifying Ruppert with Scholl is unclear. The device of Ruppert is a mortising or wood chisel. The nature of its many blades, its size, and its crude construction would prevent it from ever being used in any type of surgery involving bone in the human body, much less to “assess impaction into the bone.” Regardless, there is no motivation to modify the chisel of Ruppert with the lumen and guidewire of Scholl. Pursuant to the “Examination Guidelines for Determining Obviousness Under 35 U.S.C 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (hereinafter “the Guidelines”), when considering obviousness the operative question is “whether the improvement is more than the predictable use of prior art elements according to their established function.” The improvement provided by the claimed invention is not predictable in light of Ruppert and Scholl. Ruppert clearly discloses a mortising or woodworking tool that has no need for an inner lumen or a guidewire. In fact, if Ruppert were modified with an inner lumen, the lumen would be useless because it would become impacted with wood shavings as the chisel is chiseling wood. In addition, the intended use and shape of the tool of Ruppert would render a guidewire completely useless. With regard to use, as noted above the tool is used for mortising. It is not inserted through tissue or anything that would impair visibility, and thus necessitate the use of a guidewire. Instead, the tool is directly inserted into wood, and thus the user can simply align the tool with their naked eye. With regard to shape, because the distal most end of the tool has an



elongated and slanted blade (2), as shown in FIG. 1 of Ruppert which is reproduced herein with markings, the guidewire would exit the tool somewhere near the center of the tool at a location that is proximal to the distal end of the blade (as shown by the dashed line). In this position, so far from the distal end of the tool, the guidewire would not be suitable to provide any guidance for the distal tip of the tool. Accordingly, one skilled in the art would have no motivation to modify Ruppert in view of Scholl.

Furthermore, there would be no reasonable expectation of success in combining Ruppert and Scholl, and such a modification may even render the device of Ruppert unsatisfactory for its intended purpose. As can be seen in FIGS. 1 and 2 of Ruppert, the shape and thinness of the tool would make it nearly impossible for it to accommodate an inner lumen without compromising the blade's structural integrity. All of the teeth on the body of Ruppert are intended to chisel wood. If a lumen were added to the blade, it's doubtful that the blade would retain enough structural integrity to support all of the teeth during chiseling. Even if an inner lumen could be formed within the blade, the teeth are formed so deeply into the body of the blade that an inner lumen may actually sever the teeth from the blade. This would render the tool unusable and unsatisfactory for its intended purpose. Thus, there is no reasonable expectation of success in modifying the device of Ruppert with the lumen and guidewire of Scholl, and such a modification may actually render the device of Ruppert unusable.

For all of these reasons, independent claim 1 as well as claims 2-3 and 5-15 which depend therefrom, distinguish over Ruppert in view of Scholl and represent allowable subject matter.

#### New Claims 34 and 35

New claims 34 and 35 also distinguish over Ruppert in view of Scholl. New claim 34 recites the same limitations as independent claim 1 as previously presented and further requires that a cutting edge have an arcuate shape. The teeth of Ruppert clearly do not have a cutting edge with an arcuate shape, and it would serve no purpose to make the cutting edge arcuate, especially when the cuts required by a wood chisel in making mortises are rectangular. Scholl does not remedy this deficiency. New claim 35 recites a cutting element having a wedge-shape that increases in width in a proximal to distal direction. As can be seen in FIGS. 2 and 3 of Ruppert, the teeth of Ruppert have a constant width extending from the body of the tool in a proximal to distal direction. Scholl does not remedy this deficiency.

Accordingly, both new claims 34 and 35 distinguish over Ruppert in view of Scholl and represent allowable subject matter.

Ruppert, Scholl, and Boucher

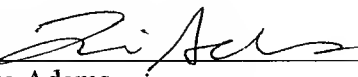
Claims 16-18 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Ruppert and Scholl in view of U.S. Patent No. 5,658,289 of Boucher et al. ("Boucher"). The Examiner argues that Ruppert and Scholl disclose the claimed invention except for a locking mechanism. The Examiner therefore relies on Boucher to disclose the claimed locking mechanism. As noted above, Ruppert and Scholl fail to disclose independent claim 1, and Boucher simply teaches a graft protection device that does not remedy the deficiencies of Ruppert and Scholl. Accordingly, claims 16-18 distinguish over Ruppert and Scholl in view of Boucher, at least because they depend from an allowable base claim.

***Conclusion***

Applicants submit that all claims are in condition for allowance for at least the reasons discussed above, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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